

**IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ALABAMA**

UNITED WAY WORLDWIDE,

Plaintiff,

V.

CATRENA NORRIS CARTER,

Defendant.

CASE NO. _____

JURY TRIAL DEMANDED

COMPLAINT FOR DAMAGES AND INJUNCTIVE RELIEF

United Way Worldwide (“United Way”), through its counsel, hereby files this Complaint against Defendant Catrena Norris Carter (“Defendant”) for injunctive relief and damages, as follows:

THE PARTIES

1. Plaintiff United Way Worldwide, a not-for-profit corporation organized under the laws of New York with its principal place of business at 701 N. Fairfax Street, Alexandria, Virginia 22314, is the service mark owner and conducts business throughout the United States.

2. Defendant is believed to have addresses at 8601 4th Avenue S, Birmingham, Alabama 35206-2802, and 2308a Tyler Road, Vestavia, Alabama 35226-2416.

JURISDICTION AND VENUE

3. This Court has original jurisdiction in this matter based on 28 U.S.C. § 1331 in that various of the claims in this case arise under the laws of the United States. Specifically, this Court has subject matter jurisdiction pursuant to 15 U.S.C. §§ 1114 and 1125 and 28 U.S.C. §§ 1331, 1332, and 1338.

4. This Court has personal jurisdiction over Defendant because, *inter alia*, Defendant transacts business within and has availed herself of this forum; engages in a persistent course of conduct in this forum; expects, or should reasonably expect, its acts to have legal consequences in this forum; and maintains substantial, systematic and continuous contacts in this forum.

5. Venue is proper in the United States District Court for the Northern District of Alabama pursuant to 28 U.S.C. § 1391(b)(1) in that Defendant resides in this District.

BACKGROUND

United Way's Activities and Service Mark

6. United Way is the leadership and support organization for the network of nearly 1,800 community-based United Ways in more than 40 countries and territories worldwide.

7. United Way fights for the health, education, and financial stability of every person in every community. Supported by 2.8 million volunteers, 9.8 million

donors worldwide, and \$4.7 billion raised every year, United Way is the world's largest privately-funded nonprofit organization. United Way works to create sustainable solutions to the challenges facing the world.

8. United Way's partners include global, national and local businesses, nonprofits, government, civic and faith-based organizations, along with educators, labor leaders, health providers, senior citizens, and students.

9. United Way has used the mark WOMEN UNITED in connection with its promotion of the interests of member organizations engaged in charitable fund raising for health and human services agencies, and organizing and conducting volunteer programs and community service projects in the United States of America since at least as early as February 25, 2015.

10. United Way's WOMEN UNITED services are organized by a dynamic group of local women committed to helping their neighbors in need and stabilizing families facing poverty. These women pledge financial gifts and take action through volunteering, advocacy, networking, and educational events.

11. United Way owns United States Service Mark Registration No. 4866043 for WOMEN UNITED in International Class 35 for "association services, namely, promoting the interests of member organizations engaged in charitable fund raising for health and human services agencies; charitable services, namely, organizing and conducting volunteer programs and community service projects"

and International Class 36 for “eleemosynary services in the field of monetary donations for human services organizations” (the “WOMEN UNITED mark”). A true and correct copy of the certificate of registration for the service mark registration for the WOMEN UNITED mark is attached as Exhibit “A”.

12. United Way has expended substantial time and effort to develop and protect the value of the WOMEN UNITED mark.

13. The WOMEN UNITED mark is an inherently distinctive mark and is widely recognized by the public as a source identifier for United Way’s services.

Defendant’s Activities and Unlawful Conduct

14. Defendant, without the authorization or consent of United Way, is providing a website, available at <womenunitednow.org>, and social networking pages on Facebook and Twitter, available at <<https://www.facebook.com/WomenUnitedNow/>> and <<https://twitter.com/womenunited>>, respectively, that promote public awareness of activism and community organizing in connection with the marks WOMEN UNITED and WOMEN UNITED NOW. See screenshots of Defendant’s website and social networking pages attached as Exhibit “B”.

15. Defendant’s unlawful use of the marks WOMEN UNITED and WOMEN UNITED NOW is likely to cause confusion in the minds of United

Way's actual and potential donors, recipients of funds, and prospective new members of United Way's WOMEN UNITED groups.

16. Given that the service marks are identical in whole or in part, reasonable ordinary consumers will mistakenly believe that Defendant's services are sponsored, authorized, or approved by United Way.

17. Defendant's unauthorized conduct constitutes federal trademark infringement and false designation of origin, is likely to cause confusion to consumers, and causes United Way to suffer irreparable injury for which it has no adequate remedy at law.

COUNT I

Federal Trademark Infringement, 15 U.S.C. § 1114

18. The allegations of paragraphs 1 through 17 are incorporated herein.

19. Defendant, with knowledge of United Way's ownership of the federally registered WOMEN UNITED mark, has used and continues to use the marks WOMEN UNITED and WOMEN UNITED NOW in the offer of her own services.

20. Defendant's use in commerce of United Way's valuable WOMEN UNITED mark is likely to cause confusion, to cause mistake, and/or to deceive consumers and others regarding the source of the services offered by Defendant.

21. Defendant's actions constitute infringement of United Way's federally registered WOMEN UNITED mark in violation of 15 U.S.C. § 1114.

22. As a result of Defendant's conduct, United Way has suffered and continues to suffer immediate, irreparable damage for which there is no adequate remedy at law.

COUNT II

Violation of 15 U.S.C. 1125(a); False Designation of Origin and False Representation

23. The allegations of paragraphs 1 through 22 are incorporated herein.

24. Defendant, with knowledge of United Way's exclusive rights in and to the WOMEN UNITED mark, and intending to trade on the goodwill and reputation of United Way in the marketplace, has adopted and used the marks WOMEN UNITED and WOMEN UNITED NOW in the offer and sale of her services.

25. Defendant's use of the WOMEN UNITED and WOMEN UNITED NOW marks constitutes a false designation of origin, a false or misleading description of fact, and a false or misleading representation of fact that Defendant's services originate with, are sponsored by or approved by United Way, or that Defendant and its services are affiliated with, connected to, or associated with United Way.

26. Defendant's actions constitute a violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

27. As a result of Defendant's conduct, United Way has suffered, and continues to suffer, immediate, irreparable damage for which there is no adequate remedy at law.

COUNT III

Common Law Trademark Infringement

28. The allegations of paragraphs 1 through 27 are incorporated herein.

29. United Way owns and enjoys in the State of Alabama and throughout the United States common law trademark rights in the WOMEN UNITED mark.

30. On information and belief, Defendant's acts have been committed knowingly, in bad faith, and with the intent to cause confusion, mistake, and deception among consumers.

31. Defendant's acts constitute infringement of United Way's common law rights in the WOMEN UNITED mark.

32. As a result of Defendant's conduct, United Way has suffered and continues to suffer irreparable damage.

33. United Way has no adequate remedy at law and is therefore entitled to preliminary and permanent injunctive relief.

34. Defendant's actions are unlawful and have damaged United Way in an amount not yet calculated.

RELIEF SOUGHT

WHEREFORE, United Way demands that:

- A. Judgment be entered in favor of United Way and against Defendant as to each of the above Counts;
- B. Defendant pay damages incurred by United Way as a result of the unlawful acts perpetrated by Defendant;
- C. An accounting be ordered to determine the profits realized by Defendant due to the unauthorized use of the WOMEN UNITED and WOMEN UNITED NOW marks;
- D. Defendant pay three times such profits or damages, whichever is greater;
- E. Defendant, and any agents, servants, employees, representatives, successors, assigns, attorneys, licensees, and all persons in active concert or participation with Defendant, be enjoined from directly or indirectly:
 - i. using the WOMEN UNITED and WOMEN UNITED NOW marks and using any confusingly similar designation, alone or in combination with other words, as a trademark, service mark, domain name, or trade name to identify, market, distribute,

advertise, promote, to offer for sale or to provide any goods or services;

ii. otherwise infringing the WOMEN UNITED mark;

iii. continuing acts of false designation of origin, or doing any acts that may cause Defendant's services to be mistaken for, confused with, or passed off as United Way's services;

iv. applying for or attempting to register with any governmental entity, including but not limited to the United States Patent and Trademark Office, any trademark or service mark consisting in whole or in part of the WOMEN UNITED mark;

F. Defendant be required to remove the WOMEN UNITED and WOMEN UNITED NOW marks and any confusingly similar name or mark from its website(s) including but not limited to <womenunitednow.org>, all social media hubs, HTML code, search engine query terms, and any other electronic communications hosts, links and devices;

G. Defendant be ordered to transfer to United Way the <womenunitednow.org> domain name, the @womenunited Twitter handle, the @WomenUnitedNow Facebook short URL, and any other domain name and social networking handle or username containing the WOMEN UNITED mark and any confusingly similar designation;

- H. Defendant be directed to file with this Court and to serve on United Way, within ten (10) days after issuance of an injunction, a report in writing, under oath, setting forth in detail the manner and form in which Defendant has complied with the injunction;
- I. Defendant be ordered to pay attorney's fees and costs of this action reasonably incurred by United Way in connection with Defendant's willful acts of trademark infringement and false designation of origin; and
- J. Such other and further relief as this Court deems just and proper.

DEMAND FOR JURY TRIAL

United Way hereby demands a trial by jury on all claims that may be tried before a jury.

Respectfully submitted,

s/Robert R. Baugh

Robert R. Baugh, Esq.

Attorney for Plaintiff, United Way Worldwide

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